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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   Michael J. BORG

Application No.: 09/991,752

Filing Date: 26 NOV. 2001

Title: METHOD FOR AUTOMATICALLY COMPLETING AN ELECTRONIC FORM

Confirmation No.: 3959

Examiner: LIN, Wen Tai

Group Art Unit: 2154

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on   **23 SEPT. 2005**   .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( )	one month	$120.00
( )	two months	$450.00
( )	three months	$1020.00
( )	four months	$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of ___**$500.00**___. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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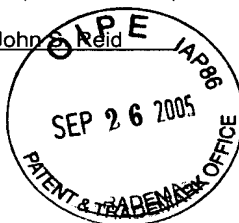
PATENT APPLICATION
Docket No.: 10007023-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Inventor(s):	Michael J. BORG
Serial No.:	09/991,752
Filed:	November 26, 2001
Title:	METHOD FOR AUTOMATICALLY COMPLETING AN ELECTRONIC FORM
Art Unit:	2154
Examiner:	LIN, Wen Tai
Confirmation No.:	3959

Mail Stop APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

SIR OR MADAM:

This communication is the Appeal Brief in this application as filed contemporaneously with the corresponding Notice of Appeal on September 23, 2005. This Appeal Brief is being filed under the provisions of 37 C.F.R. § 41.37. The filing fee for filing this Appeal Brief, as set forth in 37 C.F.R. § 1.17(c), is included herewith as indicated on the attached Transmittal of Appeal Brief.

(Continued on next page.)

1.   Real Party In Interest:

The real party in interest is Hewlett Packard Development Company, L.P., a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

2.   Related Appeals and Interferences:

There are no other appeals or interferences known to the Appellant, the Appellant's legal representative, or assignee which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

3.   Status of the Claims:

The following list provides the status of all the claims in the application:
Claims 1-20: rejected – currently on appeal.

4.   Status of Amendments:

No amendments to the claims were made, filed or entered after the final action.

5.   Summary of Claimed Subject Matter:

In one aspect, the present invention provides an automated data entry method (Fig. 4), comprising entering user information (410 of Fig. 4) at a first location, and then searching a storage medium (340 of Fig. 3) at said first location to determine an identity of a user based on the entered information (415 of Fig. 4; and pg. 5, lines 21-27 of Specification). The method includes accessing a storage medium at a second location (325 of Fig. 3; and 445 of Fig. 4), upon not being able to identify a user by searching the storage medium at said first location. The medium at the second location contains information for a plurality of users (pg. 4, line 22 to pg. 5, line 10 of the Specification). The method also includes searching the storage medium at the second location (450 of Fig. 4) to determine an identity of said user based on the entered information (pg. 6, lines 12-17 of Specification). The method further includes retrieving additional information pertaining to the user from the storage medium at the first or second

locations based on the determined identity (430 and 435 of Fig. 4; and pg. 6, lines 4-10 and 18-24 of Specification).

In another aspect, the present invention provides a system including a first website (330 of Fig. 3) corresponding to a vendor of products or services, the first website having a storage medium (340 of Fig. 3) containing user information corresponding to a plurality of individuals. The system includes a second website (320 of Fig. 3) having a storage medium (325 of Fig. 3) containing user information corresponding to a plurality of individuals. The system also includes a network connecting said first and second websites (300 of Fig. 3; and pg. 5, lines 5-10 of Specification). The system includes a user station (310 of Fig. 3) connected to the network, the first website comprising a software application (335 of Fig. 3) being programmable to communicate with the second website and to search and to retrieve user information from the storage medium at the first and second websites in response to information entered through a user interface of the user station (pg. 5, line 12 to pg. 6, line 24 of Specification). Also, the software application is further programmed to determine the identity of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the first and second websites (pg. 5, lines 24-27; and pg. 6, lines 12-14 of Specification).

6.   Grounds of Rejection to be Reviewed on Appeal:

(A).   Whether claims 1-11 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,199,079 ("Gupta").

(B).   Whether claims 12-20 are unpatentable under 35 U.S.C. § 103(a) over Gupta.

7.   Argument:

(A).   Gupta fails to teach or suggest all of the elements and limitations as recited by Claims 1-11.

A1.   Claims 2-11 depend (directly or indirectly) from Independent claim 1. Therefore, claims 2-11 include all of the elements and limitations of claim 1, in combination with their own respective elements and limitations.

Claim 1 recites:

An automated data entry method comprising:

entering a user information at a first location;

searching a storage medium at said first location to determine an identity of a user based on the entered information;

accessing a storage medium at a second location upon not being able to identify a user by searching the storage medium at said first location, said medium at the second location containing information for a plurality of users;

searching the storage medium at the second location to determine an identity of said user based on the entered information; and

retrieving additional information pertaining to the user from the storage medium at the first or second locations based on the determined identity.

Thus, under pending claim 1 (and rejected claims 2-11 that depend therefrom), a method is provided wherein a user inputs information at a first location. Responsive thereto, user information pre-stored at that first location is searched in order to determine that user's identity. In the event that the user's identity cannot be determined based on the pre-stored data at the first location, a second location including pre-stored user information is searched using the same user input information so as to determine the user's identity. Once a user's identity has been successfully determined, additional information is retrieved from the first or second locations. In this way, two electronic sources can be searched as needed to determine a user's identity and to extract additional information related to that user based on a relatively minimal initial input. For example, the user input information can include a last name and a zip code (pg. 5, lines 27-28 of the Specification). Also, for example, the first location and the second location can be defined by a vendor website and a data website, respectively (pg. 5, lines 24-27; and pg. 6, lines 12-14 of the Specification). Furthermore, for example, the additional user information retrieved from the first or second location can include a telephone number, age range, etc. (pg. 7, lines 3-8 of the Specification). Please also refer at least to page 5, line 21 to page 7, line 14 of the Specification as originally filed.

A2.   Gupta (6,199,079) teaches the automatic completion of online forms, such as those encountered by a user while shopping via the Internet (Abstract; Figs. 2C-2D of Gupta, et seq.). Under Gupta, various user-information fields (202, 204, 206, etc.) within an online form (201) are automatically filled in using user data pre-stored within a User Meta-database (170) (Col. 8, lines 15-21 of Gupta). However, Gupta fails to provide any teachings or suggestions relating to searching, accessing or in any way utilizing a _second location_ (of any kind) for purposes of _identifying a user_ and/or retrieving _additional_ (or any) _user information_ from such a _second location_. The Examiner has admitted to the foregoing deficiencies of Gupta (page 3 of Final Office Action). Gupta teaches the storage of user information in and the retrieval of user information from the User Meta-database 170 <u>exclusively</u>. In short, Gupta teaches a system configured about a <u>single</u> electronic source of user information, and no other.

Despite the foregoing facts, the Examiner has asserted that it would be obvious to one of ordinary skill in the art at the time the invention was made that, when the users identity is not found in the local database, Gupta's <u>form filler</u> (110 of Fig. 1C) **"is able to"** search and obtain a respective vender's customer records for the underlying user's _identity_ and _additional (user) information_ such as specific forms required for the vendor's product because Gupta's system is designed to integrate the various vendor's database information to the form filler's local database. (See page 3 of Final Office action.) It is noted that the Examiner has **not** asserted that the form filler 110 of Gupta is <u>modified</u> in any way, but rather the Examiner asserts that such a form filler 110 _**"is able to"**_ (i.e., as currently described by Gupta, has the capability to) search for the identity of the user and obtain additional user information, as-is.

Respectfully, the Examiner is mistaken. In fact, Gupta provides <u>no</u> teachings or suggestions that the form filler 110 - or any other means taught thereby, for that matter - is **able to** _determine an identity of a user_, or to search for _user information in response to that determination_, in any way or for any purpose. Gupta provides <u>no</u> teachings or suggestions, whatsoever, as to _how_ any sort of user identification is determined. Therefore, any assertion that Gupta teaches, suggests, or in any way renders obvious _the searching of a storage medium at a first location to determine an identity of a user_ and then, upon not being able to identify a user by way of the first location, _searching the storage medium at the **second location** to determine an identity of the user_, as

recited in combination with the other features and limitations of claim 1, is completely unfounded.

The Examiner has further asserted that, since the transaction integrator (100 of Fig. 1C of Gupta) **"is able to"** perform searching or accessing on a local database 170 as well as those of remote merchandising sites, it is obvious to obtain buyer's information from specific vendor websites in the event that such information is not established in a local database, because [the transaction integrator's] associated wrapper serves such functionality. (See page 6 of Final Office action.) Again, the Examiner fails to assert that any modification of the transaction integrator 100 is required, but rather the Examiner asserts that the transaction integrator 100 **"is able to"** (i.e., as currently described by Gupta, has the capability to) obtain such *user information* from a vendor's website as-is. However, the Appellants assert that the Examiner has misinterpreted the teachings of Gupta. Gupta *only* teaches that: "Transaction integrator 100 controls responding to the user's requests to search for various merchandise, obtaining information *from the user* about the user's merchandise selections from the search results and building information into the User Meta-database 170 and the User Selection database 180." (Col. 6, lines 22-27 of Gupta; emphasis added.) Therefore, Gupta only teaches that the transaction integrator 100 obtains *user* information *directly from the user* for purposes of building the User Meta-database 170. Gupta does **not** teach, suggest or motivate – and thus, does not render obvious - using the transaction integrator 100 for purposes of *searching for user information* within any other (second) location, or by way of any other entity such as an associated wrapper. To summarize the foregoing, the Examiner has asserted that particular elements of Gupta (i.e., the transaction integrator 100 and form filler 110) can be used (as-is) to perform specific method steps as recited by independent claim 1 when, in fact, Gupta provides **no** teachings or suggestions to support any such assertions.

More to the point, Gupta teaches: "Automated form filling component [i.e., form filler] 110 interacts with User Meta-database 170 and the User Selection database 180 in order to perform filling in of online forms presented by various shopping sites." (Col. 6, lines 19-22 of Gupta.) Gupta also teaches that: "Forms associated with a vendor's site corresponding to product selections made by a user are automatically filled in with the information stored in the User Meta-database 170 and the User Selection database 180 ...." (Col. 8, lines 15-18 of Gupta.) Furthermore, Gupta teaches that: "The data to

be filled into each form is obtained from <u>the User Meta-database 170</u> and the User Selection database 180." (Col. 8, lines 59-61 of Gupta.) To clarify, the User Meta-database 170 stores user meta data, such as the user's name (Col. 6, lines 37-38 of Gupta), while the User Selection database 180 stores data corresponding to selected purchase items (Col. 7, lines 44-50 of Gupta). Gupta does not teach, suggest or motivate – and thus, does not render obvious – storing, searching or accessing user information anywhere except within the (singular) User Meta-database 170.

In any case, Gupta fails to provide, teach or suggest an automated data entry method, including: 1) accessing a storage medium at a <u>*second location*</u> upon not being able to <u>*identify a user*</u> by searching the storage medium at said first location; 2) searching the storage medium at the <u>*second location*</u> to <u>*determine an identity*</u> of said user based on the entered information, and 3) retrieving additional information pertaining to the user from the storage medium at the <u>*first or second*</u> locations based on the <u>*determined identity*</u>, as recited by claim 1. Accordingly, Gupta fails to teach or suggest at least the foregoing method steps as positively recited by claim 1. Thus, Gupta fails to teach or suggest all of the elements and limitations as recited by claims 1-11. Furthermore, Gupta fails to convey any <u>reasonable expectation of success</u> with respect to searching <u>*first*</u> and (if need be) <u>*second locations*</u> to <u>*determine a user's identity*</u> or to <u>*obtain user information*</u>. Such deficiencies on the part of Gupta render the § 103 rejection of claims 1-11 unsupportable in view of the requirements of MPEP 706.02(j) and MPEP 2143.03.

A3. In view of the foregoing, the Appellant respectfully submits that the § 103(a) rejection of claim 1 under Gupta must fail for impropriety, and that the Board must accordingly overturn this rejection. It is axiomatic that any claim which depends (directly or indirectly) from an allowable base claim is also allowable. Therefore, the Appellant asserts that claims 2-11 are also allowable at least by virtue of their dependence from allowable claim 1, as well as for their own respectively patentable features and limitations. Thus, the Appellants do not offer specific arguments in response to the respective § 103(a) rejections of claims 2-11 over Gupta.

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(B). <u>Gupta fails to teach or suggest all of the elements and limitations as recited by Claims 12-20.</u>

B1.   Claims 13-20 depend (directly or indirectly) from Independent claim 12. Therefore, claims 13-20 include all of the elements and limitations of claim 12, in combination with their own respective elements and limitations.

Claim 12 recites:

A system comprising a first website corresponding to a vendor of products or services, said first website having a storage medium containing user information corresponding to a plurality of individuals;

a second website having a storage medium containing user information corresponding to a plurality of individuals;

a network connecting said first and second websites;

and a user station connected to the network, the first website comprising a software application being programmable to communicate with the second website and to search and to retrieve user information from the storage medium at the first and second websites in response to information entered through a user interface of the user station, and wherein the software application is further programmed to determine the identity of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the first and second websites.

Therefore, under pending claim 12 (and rejected claims 13-20 that depend therefrom), a system is provided wherein a user, by way of a user station, inputs user information to a software application resident at a first website. The software application is programmed to cause a search of user information at the first website and, if necessary, at a second website, so as to identify the user based on the user's input. Upon identification of the user, other user information can be retrieved from the first and/or second websites. By the foregoing means, a plurality of electronic sources of pre-stored user information, each being typically remote to a user station, can be searched and additional user information can be retrieved therefrom in response to an initial user input. Please refer at least to page 5, line 5 to page 7, line 14 of the Specification as originally filed.

B2.   As argued at (A2) above in regard to claim 1, Gupta teaches only the use of a single electronic source – namely, the User Meta-database 170 - for any purpose related to storing or accessing user information. Gupta does not teach, suggest or motivate (and thus, does not render obvious): 1) *first and second websites* each including a storage medium containing *user information*; and 2) a software application resident at the first website and programmable to communicate with the *second website*, the software application programmed to *search and to retrieve user information* from the storage medium at the *first and second websites*, as recited by claim 12. Furthermore, Gupta does not teach, suggest or motivate (and thus, fails to render obvious): 3) any such software application that is programmed to *determine the identity* of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the *first and second websites*, as recited by pending claim 12.

Accordingly, Gupta fails to teach or suggest at least the foregoing elements and limitations as positively recited by claim 12. Thus, Gupta fails to teach or suggest all of the elements and limitations as recited by claims 12-20. Furthermore, Gupta fails to convey any reasonable expectation of success with respect to the specific functionality of the software application as recited by pending claim 12. Such deficiencies on the part of Gupta renders the § 103 rejection of claims 12-20 unsupportable in view of the requirements of MPEP 706.02(j) and MPEP 2143.03.

B3.   In view of the foregoing, and for reasons analogous to those argued at (A2) above, the Appellant respectfully submits that the § 103(a) rejection of claim 12 under Gupta must fail for impropriety, and that the Board must accordingly overturn this rejection. In turn, the Appellant asserts that claims 13-20 are also allowable at least by virtue of their dependence from allowable claim 12, as well as for their own respectively patentable features and limitations. Thus, the Appellants do not offer specific arguments in response to the respective § 103(a) rejections of claims 13-20 over Gupta.
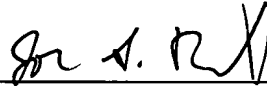
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Summary

The Applicant respectfully considers claims 1-20 to be in condition for allowance, and respectfully requests the Board to overturn the final rejections of those claims, and further requests that those claims be allowed.

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Dated this 23rd day of September, 2005.

Respectfully submitted,

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15
Attorney and Agent for Appellant
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8.   Claims Appendix:

Claim 1. An automated data entry method comprising:

entering a user information at a first location;

searching a storage medium at said first location to determine an identity of a user based on the entered information;

accessing a storage medium at a second location upon not being able to identify a user by searching the storage medium at said first location, said medium at the second location containing information for a plurality of users;

searching the storage medium at the second location to determine an identity of said user based on the entered information; and

retrieving additional information pertaining to the user from the storage medium at the first or second locations based on the determined identity.

Claim 2. The method of claim 1 further comprising:

establishing communication from the first location to the second location by a programmable software application at the first location.

Claim 3. The method of claim 2 wherein said software application is a browser plug-in module.

Claim 4. The method of claim 1 wherein the first and second locations are connected to a network.

Claim 5. The method of claim 4 wherein the network is the Internet.

Claim 6. The method of claim 1 wherein the first and second locations are respectively defined by a first website and a second website.

Claim 7. The method of claim 6 wherein said first website is associated with a vendor.

Claim 8.   The method of claim 1 wherein the retrieved additional information is presented to the user for verifying accuracy of said information.

Claim 9. The method of claim 8 further comprising the steps of:

verifying an accuracy of said retrieved additional information,

appending the additional information to the entered user information;

transmitting said entered information and said appended additional information; and

processing said transmitted information to complete a transaction.

Claim 10. The method of claim 9 wherein the user selects portions of the additional information for transmission.

Claim 11. The method of claim 2 wherein the application is further programmable to search a database associated with the first location.

Claim 12. A system comprising:

a first website corresponding to a vendor of products or services, said first website having a storage medium containing user information corresponding to a plurality of individuals;

a second website having a storage medium containing user information corresponding to a plurality of individuals;

a network connecting said first and second websites; and

a user station connected to the network, the first website comprising a software application being programmable to communicate with the second website and to search and to retrieve user information from the storage medium at the first and second websites in response to information entered through a user interface of the user station, and wherein the software application is further programmed to determine the identity of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the first and second websites.

Claim 13. The system of claim 12 wherein the network is the Internet.

Claim 14. The system of claim 12, wherein said first website presents a plurality of products or services offered by a vendor.

Claim 15. The system of claim 14, wherein said first website includes links to additional information pertaining to said products or services.

Claim 16. The system of claim 12, wherein said first website facilitates a transaction between the user and the vendor.

Claim 17. The system of claim 12, wherein said first website contains information pertaining to a plurality of users.

Claim 18. The system of claim 12, wherein the user selects at least one product or service for purchase from the vendor.

Claim 19. The system of claim 18, wherein a user selection is displayed to the user.

Claim 20. The system of claim 19, wherein the user is prompted to enter information for shipping and billing purposes.

-- End of Claims Appendix --

(Continued on next page.)

9.   <u>Evidence Appendix:</u>

No evidence is submitted in the Evidence Appendix.

10.   <u>Related Proceedings Appendix:</u>

5   No evidence is submitted in the Related Proceedings Appendix.